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No. 471

In the Supreme Court of the United States

OCTOBER TERM, 1960

[illegible]RMED LINE PRODUCTS COMPANY, PETITIONER

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

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OPINIONS BELOW

The findings of fact, conclusions of law, and the oral opinion of the United States District Court for the District of Columbia (R. 26-35, 44-53)[1] are unreported. The opinion of the United States Court of Appeals for the District of Columbia Circuit (Pet. App. A-1 to A-4) is reported at 280 F. 2d 643. An earlier opinion in the same case is reported at 257 F. 2d 664, certiorari denied, 358 U.S. 945.

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[1] "R." refers to the Joint Appendix in the court below.

JURISDICTION

The judgment of the Court of Appeals was entered on June 9, 1960. On August 29, 1960, the time for the filing of the petition for a writ of certiorari was extended to October 7, 1960, by order of the Chief Justice. The petition was filed on October 7, 1960. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED

1. Whether, in a proceeding in a United States District Court to order the Commissioner of Patents to issue a patent, the District Court has jurisdiction to deny the order on the ground that the claims lack the novelty essential to a patentable invention when the Patent Office had rejected the claims on a different ground.

2. Whether the District Court, as an alternative ground for denying relief, properly accepted a final judgment of the Board of Interference Examiners, from which an appeal had been noted to the Court of Customs and Patent Appeals but had not been prosecuted, as *res judicata* of a determination against the petitioner made therein.

STATUTE INVOLVED

35 U.S.C. 145 provides as follows:

> An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action

against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the appellant.

STATEMENT

The petitioner is the assignee of a patent application for a method and an apparatus for wrapping armor wire around another wire or cable for the purpose of reenforcing or splicing it, or forming terminals (R. 170-188). After multiple procedural steps,[2] the Board of Appeals in the Patent Office finally denied certain of the claims in the application on the ground that they were not supported by disclosures in the application (R. 298-340, 420, 430). In reaching this decision the Board held that, in certain aspects, it was bound by a prior decision of the Board of Interference Examiners, to which the application had previously been referred when the

[2] These proceedings are detailed in the Petition (pp. 1-7) and in the Government's Brief in Opposition when the case was before the Court on the prior appeal. See Brief in Opposition in No. 554, October Term, 1958.

applicant had claimed interference. After the Interference Examiners had decided adversely to this applicant, and he had noted an appeal to the Court of Customs and Patent Appeals, the competing inventor had entered a disclaimer and concession of priority. However, the Commissioner of Patents had ruled, on motion to vacate the appeal filed by the petitioner, that since an appeal had been noted he had no authority over the issue. The appeal was not prosecuted in the Court of Customs and Patent Appeals, and the determinations of the Interference Examiners became final and were accepted as *res judicata* in the further proceedings in the Patent Office.

Following the denial of the claims by the Patent Office, the petitioner instituted suit in the District Court under 35 U.S.C. 145 to compel the Commissioner of Patents to issue the patent on the rejected claims. The District Court denied the order, first, on the ground adopted by the Patent Office and, alternatively, on the ground that the claims lacked the novelty essential to patentability. On appeal, the Court of Appeals, without passing on the first ground, sent the case back in order to permit the petitioner to present its case on patentability. This Court denied a petition for certiorari on this order. *Preformed Line Products* v. *Watson*, 358 U.S. 945.

On remand, the District Court considered the proffer of evidence submitted by the petitioner to support its motion for a new trial and reaffirmed its holding that there was no showing of novelty. On appeal, the court below affirmed the order of the District Court.

ARGUMENT

1. The petitioner's chief complaint is that the District Court in a proceeding under 35 U.S.C. 145 reached its determination denying certain patent claims on a ground not followed by the Patent Office, namely, that the claims lacked novelty. The attack is not on the findings themselves, but on the authority of the court to consider the issue *sua sponte*. Both courts upheld the power of the courts to consider the issue, and both the language of the statute and its prior construction support them in that position.

The language of the statute, 35 U.S.C. 145, *supra*, pp. 2-3, seems clearly to contemplate not only that the court will decree whether the moving party has been aggrieved by the action of the Patent Office, but that its determination shall constitute a determination of whether the applicant is entitled to a patent. Thus, the statute provides:

> * * * The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law.

Since, under 35 U.S.C. 101, to justify a patent an invention must be a "new and useful" process or machine, it seems clear that a court may not order the Commissioner to issue a patent without considering this basic condition precedent.

In *Hill* v. *Wooster*, 132 U.S. 693, the Patent Office had determined a question of priority in an interference proceeding between two inventors. In the Circuit Court, where a suit in equity had been commenced to reexamine this decision, priority was determined in favor of the plaintiff. The Supreme Court, however, decided the dispute not on the basis of priority, but on the ground that the claims were not entitled to a patent. The Court stated at 698:

> The provision of section 4915 is that the Circuit Court may adjudge that the applicant "is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear;" and that, if the adjudication is in favor of the right of the applicant, it shall authorize the Commissioner to issue the patent. It necessarily follows that no adjudication can be made in favor of the applicant, unless the alleged invention for which a patent is sought is a patentable invention. * * *
>
> The parties to the present suit appear to have been willing to ignore the question as to patentability in the present case, and to have litigated merely the question of priority of invention, on the assumption that the invention was patentable. But neither the Circuit Court nor this court can overlook the question of patentability. * * *
>
> We are of opinion that nothing in those four claims constitutes a patentable invention. * * *

See also *Sanford* v. *Kepner*, 344 U.S. 13, 15.

The petitioner seeks to distinguish these cases on the ground that they involve competing claims by inventors, rather than a proceeding by a single inventor to contest a decision by the Commissioner (Pet. 20-25). However, the procedures in the two types of proceeding (35 U.S.C. 145 and 146) derive from the same source, R.S. 4915, and the authorization in the present Section 145 is explicit in requiring the court to make a finding on whether the applicant is "entitled to receive a patent." There is no foundation for the petitioner's distinction.

2. On the separate ground for decision, which was not passed upon by the court below, the District Court upheld the Board of Review in holding that the issue of whether the claims were properly supported by the declarations was *res judicata* by reason of the final decision on that issue by the Board of Interference Examiners. Although the petitioner had attempted to reopen that decision by a motion to the Commissioner to vacate the appeal from that decision to the Court of Customs and Patent Appeals, the Commissioner had denied that motion on the ground that he had no jurisdiction after the notice of appeal had been noted. That position is correct. *Galena Manufacturing Co.* v. *Superior Oil Works*, 26 C.C.P.A. (Patents) 1301, 104 F. 2d 400; *In re Allen*, 28 C.C.P.A. (Patents) 792, 799-800, 115 F. 2d 936, 941-942; *Myers* v. *Polk Miller Products Corp.*, 40 C.C.P.A. (Patents) 739, 742, 201 F. 2d 373, 375. Thereafter, when the appeal to the Court of Customs and Patent Appeals was neither prosecuted nor remanded by that court, the decision of the Board of Interference Examiners

became final (35 U.S.C. 135) and the issues decided therein became *res judicata* in all further proceedings in connection with the application.[3]

CONCLUSION

For the foregoing reasons, we respectfully submit that the petition for a writ of certiorari should be denied.

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NOVEMBER 1960.

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[3] The petitioner argues that a contrary decision at an earlier stage in the proceeding when the application was still being considered *ex parte* was *res judicata* on the *inter partes* proceeding before the Board of Interference Examiners (Pet. 27-28). The flaw in this argument is that *ex parte* decisions are not binding on subsequent *inter partes* proceedings. *Armstrong* v. *Levy*, 29 F. 2d 953 (C.A. D.C.); *Thompson* v. *Dicke*, 27 C.C.P.A. (Patents) 931, 935-936, 110 F. 2d 98, 101-102; *Durdin* v. *Nordell*, 38 C.C.P.A. (Patents) 1187, 1191, 190 F. 2d 211, 214.

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